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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/973,293	12/01/1997	ROBERT G. SCHWARTZ	8001.101/00	6722

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11/08/2005

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EXAMINER

BASS, JON M

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/973,293	SCHWARTZ ET AL.	
	Examiner	Art Unit	
	Jon Bass	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 1997.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-28, 31-81, 130, 131, 183, 192-205, 208-210 and 1334 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-28, 31-81, 130, 131, 134-183, 192-205 and 208-210 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This is in response to an amendment filed on August 10, 2005 for patent letter filed on December 01, 1997. In the amendment, claims 26-28, 31-81, 130-131, 134-183, 192-205, 208-210 are now pending in this application.

Response to Arguments

2. Examiner notes that claims 132 and 133 were cancelled in an earlier filed amendment dated back July 18, 2000.
3. Examiner notes that claims 26-28, 31-81, 130-131, 134-183, 192-205 and 208-210 are pending in this application.
4. Applicant argues that claims 26-28, 31-35, 130-131 and 134-138 are not related to the prior art under 35 U.S.C. 102(e) by Schwartz et al. (U.S. Patent Number: 5,615,120) referred to as Schwartz. The Applicant argues that Schwartz fails to distantly teach, anticipate, or closely relate to 'obtaining, from the mail piece, selected information appearing on the mailing piece, said information including data identifying an originator of said mail piece or a processor responsive to at least the selected information for determining whether to dispense the postage as recited in claim 26 of the present application" The examiner respectfully disagrees with the applicant's characterization and depiction of the prior art for the following reasons. Referring to the reference cited, Schwartz discloses in Figure 1 an electronic postal scale system. In connection to the

postal scale, it's used for several reasons such as a essential tool to in processing a mail item. Without the electronic scale the continuation of the mail would be non-existent. The Electronic scale is needed in order to dispense a postage amount on the mail item to be delivered. In addition to, Schwartz discloses in Figure 8, element 230 that the interface can be controlled through a interface with is connected to a microprocessor. The microprocessor has the capability of controlling information, selecting information, and delivering informational data through the interface. With respect to, Figure 13 element 9, Schwartz discloses a display with displays all related data that was transferred as well as important information from the mail piece item. The display screen has information that is related to the originator, the destination, the postage amount, and the tracking information. For all the reasons stated Schwartz's rejections remains. Therefore all claims that depend upon claim 26 are in and after rejected. Claims 27-28, 31-35, 131 and 134-138 are rejected based upon Schwartz's prior art.

5. The Examiner makes note that a name difference was pointed out by the applicant. The Examiner assumes all responsibility for the typo error addressed. To clarify any discrepancies the Examiner would like to note the reference relied upon is that of Kara et al. (U.S. Patent Number: 5,812,991) referenced as Kara.
6. The Applicant argues that claims 36, 58, 139, and 161 are not anticipated by Kara for the following reason (s). The applicant suggest that Kara does not disclose or suggest "a postage indicium including a proof of payment, for service by a first party, and

transactional data comprising at least information representative of a transaction amount, said first party causing said transaction amount to be paid to a second party in response to at least said transactional data when said first party processes said postage indicium as recited in claim 36 of the present application” The Examiner respectfully disagrees with the applicant’s interpretation of the prior art by Kara for the following reasons. In regard to Figure 9 Kara displays a caption of a mail-piece with a postage indicium. Creating a postage indicium as referred by the applicant is directly related to displaying a caption if a postage indicium. In regard to Figure 3B, illustrated is a postal verification process of a postage indicium. The applicant relates this step to the “proof of payment”, mentioned. In order to have a proof of payment it must go through a verification process. In addition Kara also discloses in Figure 14 element 1403 that a meter is present for debits. For the reasons above the 35 U.S.C 102 rejection remains. Claims 58, 139 and 161 also recite similar limitations. Therefore claims 37-57, 59-81, 140-147, 149-160, 162-183, 201-204, 208 and 209 depend on claim 36 and are rejected for all the reasons stated above.

7. The applicant also argues that claims 192-205 and 208-210, taught by the prior art by Critelli et al (U.S. Patent 6,260,029) fails to teach and anticipate “ that an indicator [on the mail piece] cause a processor of the mail piece to inform a third party of information, concerning a content of the mail piece, while the mail piece is being sent”. The Examiner respectfully disagrees with the generalization made by the applicant due to the following reasons. In regard to Figure 1, Critelli discloses a sealed and unsealed mail piece that displays the contents of the mail piece. In element 35, a security postal device, which is a

serial number, is used to track and to identify the different types of mail being sent. If the package is large in size or small in diameter the serial number will identify the contents and the type of mail piece being handled. For the following reasons the 35 U.S.C. rejection 102 remains due to the reasons stated in the Office Action and for the following reasons listed. Therefor the claims 193-205 and 208-210, which depend solely on claim 192 remain rejected.

8. Below is the rejection made.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 26-28 and 31-35** are rejected under 35 U.S.C. 102(e) as being anticipated by Robert Schwartz et al. (US Patent Number 5,615,120) hereinafter referenced as Schwartz.

As Per Claims 26 and 130:

Schwartz et al. ('120) discloses:

- Fig. 1- illustrates an electronic postal scale system
- Fig. 8- (230), keyboard interface, (201), microprocessor
- Fig. 13-(9), display information on screen (col.6, lines 46-47)
- Fig. 15A, flow chart illustrating an application process perform by the system

As Per Claim 27:

Schwartz et al. ('120) discloses:

- Fig 15A-(1541) & (1543), printer and generates label
- Fig 14-(890), printer
- Col.2, line 49; optical scanner

As Per Claims 28 and 131:

Schwartz et al. ('120) discloses:

- Fig. 32- (170), barcode scanner

As Per Claims 31, 32, 134 and 135:

Schwartz et al. ('120) discloses:

- Col.2, line 29; various carriers

As Per Claims 33 and 136:

Schwartz et al.('120) discloses:

- Fig. 9, (305), zip/zone module
- Fig. 32(170), barcode scanner

As Per Claims 34 and 137:

Schwartz et al.('120) discloses:

- Fig 15A, application process performed by the system

As Per Claim 35 and 138:

Schwartz et al.('120) discloses:

- Fig 15A, application process, if verified then print the label

3. **Claims 36 -57 are rejected under 35 U.S.C. 102(e) as being anticipated by William Imlah (US Patent Number 5,812,991) hereinafter referenced as Imlah.**

As Per Claims 36, 58 and 139, 161:

Imlah discloses('991):

- Fig. 9, (display the postage indicia
- Fig 3B, illustrates postal or verification indicia
- Fig 14, (1403), debits from secure meter
- Col. 8, lines 50-56, compare information to detect unauthorized use

- Col.8, lines 38-40, indicate payment
- Col.7, lines 50-52, controls printing of postage indicia
- Col.7, lines 54-55, provides the ability to print the postage indicia

As Per Claims 37, 38, 140 and 141:

Imah ('991) discloses:

- Col.8, lines 12-15; Post Office sites and authorized agents will have installed systems complementary software installed on customers PC.

As Per Claims 39, 40, 41, 42, 64, 65, 66, 67 142, 143, 144 and 145 and 166,167, 168, 169:

Imah ('991) discloses:

- Col.8, lines 38-40, request an amount of postage and indicate payment by such valid bankcard or debit account.

As Per Claims 43, 68 and 146 and 170:

Imah ('991) discloses:

- Col.8, lines 38-40, request an amount of postage and indicate payment by such valid bankcard or debit account.

As Per Claims 44, 69 and 147 and 171:

Imah ('991) discloses

- Col.8, lines 43-44, verification of unique information

As Per Claims 45, 70 and 145 and 172:

Imah ('991) discloses:

- Col.8, lines 43-44, verification of unique information

As Per Claims 46 and 149:

Imah ('991) discloses:

- Fig. 14- (1404A); with special indicia

As Per Claims 47, 72 and 150 and 174:

Imah ('991) discloses:

- Fig.14- (1401A), with special indicia barcode

As Per Claims 48, 73, and 151 and 175:

- Fig. 3C, illustrates an encoded user registration form

As Per Claims 49, 74 and 152 and 176:

Imah ('991) discloses:

- Fig. 3C, illustrates an encoded user registration form

As Per Claims 50, 75, 153 and 177:

Imah ('991) discloses:

- Fig. 3C, illustrates an encoded user registration form

As Per Claims 51, 76 and 154 and 178:

Imah ('991) discloses:

- Fig. 3C, illustrates an encoded user registration form

As Per Claims 52, 77 and 155 and 179:

Imah ('991) discloses:

- Col. 8, lines 12-13, post office sites and authorized agents

As Per Claims 53, 78, and 156, 180:

Imah ('991) discloses:

- Col. 8, lines 12-13, post office sites and authorized agents

As Per Claims 54, 79, 157 and 181:

Imah ('991) discloses:

- Col. 8, lines 43-44, verification of unique information:

As Per Claims 55, 80, 158 and 182:

Imah ('991) discloses:

- Fig. 15-(1519), printer label maker

As Per Claims 56, 81, 159 and 183:

Imah ('991) discloses:

- Fig. 15-(1519), printer label maker

As Per Claims 57 and 160:

Imah ('991) discloses:

- Fig. 15-(1519), printer label maker

As Per Claims 59 and 162:

Imah ('991) discloses:

- Fig. 14-(1401A), envelope with special indicia

As Per Claims 60 and 163:

Imah ('991) discloses:

- Fig 14-(1407A), pass route in mail

As Per Claim 61:

Imah ('991) discloses:

- Fig. 15-(19), printer

As Per Claims 62 and 164:

Imah ('991) discloses:

- Col. 8, lines 12-14, authorized agents will have installed systems complementary to the customers PC

As Per Claims 63 and 165:

Imah ('991) discloses:

- Col. 8, lines 12-14, authorized agents will have installed systems complementary to the customers PC

As Per Claims 71 and 173:

Imah ('991) discloses:

- Fig. 14- (1404A); with special indicia

4. **Claims 192-205 and 208-210 are rejected under 35 U.S.C. 102(e)** as being anticipated by Michael Critelli et al. (US Patent Number 6,260,029 B1) hereinafter referenced as Critelli.

As Per Claim 192:

Critelli ('029) discloses:

- Col.1, lines 66-5, electronic indicium for use on a item shipped

- Col. 2, lines 1-5, electronic indicium including integrated chip having memory ,
memory has stored evidence of shipping payment and third party certified

As Per Claims 193-195:

Critelli ('029) discloses:

- Col. 2, lines 1-5, electronic indicium including integrated chip having memory ,
memory has stored evidence of shipping payment and third party certified

As Per Claim 196:

Critelli ('029) discloses:

- Fig. 3 (112), digital signature

As Per Claim 197:

Critelli ('029) discloses:

- Fig 2-(104), encrypted message digest

As Per Claim 198:

Critelli ('029) discloses:

- Fig. 8, (35, 38), includes evidence of the payment with the third party, certified,
cryptographically secured information

As Per Claims 199-205:

Critelli ('029) discloses:

- Fig. 8, (35, 38), includes evidence of the payment with the third party, certified, cryptographically secured information
- Fig 8, (33), postage amount
- Fig. 1, (33) indicia amount

As Per Claims 208-210:

Critelli ('029) discloses:

- Col. 2, lines 1-5, electronic indicium including integrated chip having memory , memory has stored evidence of shipping payment and third party certified.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any concerns in regard to this communication, the examiner **Jon Bass** can be reached at **(571) 272-6905** between the hours of **9-6pm Monday through Friday**. The fax number for the establishment where the application is being process is **(571) 273-8300**.

If an attempt to reach the examiner is unsuccessful for any reason, the examiner's immediate supervisor, **John Hayes** can be reached at **(571) 272-6708**.

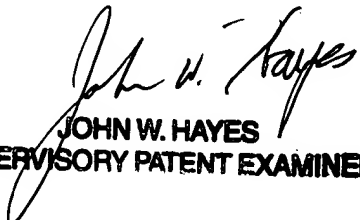
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Any response to this action should be mailed to:

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JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

